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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,003	01/16/2002	Maria Azua Himmel	AUS920010811US1	6343

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EXAMINER	
LIN, WEN TAI	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,003	HIMMEL ET AL.	
	Examiner	Art Unit	
	Wen-Tai Lin	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5/17/02
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-33 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d?2010 (Fed. Cir. 1993); In re Longi, 759 F.2d?887, 225 USPQ?645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d?937, 214 USPQ?761 (CCPA 1982); In re Vogel, 422 F.2d?438, 164 USPQ?619 (CCPA 1970);and, In re Thorington, 418 F.2d?528, 163 USPQ?644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR?1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR?1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR?3.73(b).

3. Claim 33 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/047837. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: (1) entering at least one destination address into a browser; (2) sending at least one telephone number to the destination address which corresponds to a remote device; (3) the telephone number is also entered into the browser [see claim 1 of the instant application and claim 1 of Application No. 10/047837]; and (4) capturing the telephone number from a webpage [see claim 33 of the instant application and claim 1 of Application No. 10/047837].

There is two minor differences between the two opposing claims: (1) claim 33 of the instant application allow for entry of additional information into the telephone number record and (2) claim 1 of Application No. 10/047837 sends the telephone number in a message. These are considered obvious features that a practical system implementing either claims should accommodate both features.

4. As to claims 1-32, since they are also fully disclosed in application No.10/047837, they are therefore rejected as non-statutory double patenting as set forth in the paragraphs herein above.

5. Claims 3-4, 14-17, 20-21 and 29-30 are objected to because the following terms lack antecedent basis:

In claim 3, "the at least one telephone record";

In claims 4, 14, 16, 21 and 29, "the message";

In claims 14 and 29, "the means";

In claim 20, "the at least one telephone record"; and

In claim 29, "the message".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-2, 5-15, 18-19, 22-30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669].

8. As to claims 1-2, Rossmann teaches the invention substantially as claimed including: a method of automatically capturing identified data elements such as addresses and telephone numbers from emails or web pages and store it into the email recipient's (i.e., remote user device or terminal) local address or telephone directory [see e.g., Abstract and paragraphs 45 and

55-58; note that at claims 13-17, Rossmann further teaches that a user's website is treated as user terminal].

Rossmann does not specifically teach entering at least one telephone number into a browser and send the number to at least one destination address that is associated with a remote user device, wherein the destination address is stored in the browser.

However, it is well known in the art that a user who uses Internet provider's mail services (such as hotmail.com or aol.com) may send email messages to anywhere reachable by the Internet.

As such, it would have been obvious to one or ordinary skill in the art that a user of Internet provider's mail services may send information of interest such as telephone numbers to remote email recipients by entering their email addresses into an email editor (which is provided through a web browser), or alternatively using the browser's bookmark to record the email address (which may be associated with a website), and cause the email to be sent over the internet to destination addresses that are associated with the remote users' devices or website.

9. As to claims 5-6, Rossmann further teaches that the communications terminal is selected from a mobile telephone, a personal computer, a voice mail messaging service, a FAX machine, a handheld computer, a personal digital assistant or combinations thereof, wherein the communications terminal is selected from a device that can store and retrieve information and is connectable to a telephone network [e.g., 301, Fig.3 or 400, Fig.4].

10. As to claim 7, Rossmann further teaches that each destination address is selected from the group consisting of a computer network address, Internet address, and telephone number [e.g., paragraphs 15 and 33-34; i.e., inherently the wireless device must be provided with a network address of ID for communicating with other servers in the network].

11. As to claims 8-9, Rossmann further teaches that the one or more telephone number records comprises a telephone number and an alphanumeric identifier for the telephone number, wherein the telephone number record comprises parameters selected from a telephone number, a contact name, an address, a FAX number, an e-mail address, a hyperlink to a Web site, a business name, a business specialty, business hours or combinations thereof. [paragraph 68; i.e., a telephone number can be associated with the person? name and other attributes].

12. As to claim 10, Rossmann does not specifically teach the entering steps as described in steps d-f. However, based on the example mentioned in the rejection of claim 1, it is obvious that a subscriber of the email service provider follows the same procedure to use an email composing tool, which is provided through the browser, to select an email address on an interactive display (note that the email addresses are also stored locally through the browser) because this is exactly what's been provided as part of the email service.

13. As to claim 11, Rossmann further teaches that the telephone numbers can be captured from a web page [Abstract].

14. As to claim 12, Rossmann teaches that the method further comprises: repeating steps (d) and (e) to enter additional telephone number records [note that this step are inherent in Rossmann's method because each additional telephone number record is undergoing the same procedure performed by the browser/sever software].

15. As to claim 13, Rossmann further teaches that the telephone number record comprises a telephone number and an alphanumeric identifier for the telephone number [e.g., the telephone owner name], the method further comprising:

Rossmann does not specifically teach that the modifying makes the telephone number compatible with the communication terminal's telephone system and displayed in a standard format suitable for a format of the electronic telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to edit the telephone number compatible with Rossmann communication terminal (which is a cellular phone) and displayed in accordance with the PIM or telephone book format because by doing so the stored phone numbers can be made directly usable as they are stored.

16. As to claims 14-15, Rossmann does not specifically teach the step of sending of the at least one telephone number record as described.

However, as mentioned in the rejection of claim 1, it is an obvious feature because a subscriber of the email service provider follows the similar procedure to enter an email address and send an email message to an intended recipient, wherein it is an option (i.e., design choice)

to mark the message (e.g., by entering in the subject of the email that a telephone record is contained in the mail.

17. As to claims 18-19, 22-30 and 33, since the features of these claims can also be found in claims 1-2, 5-11 and 13-15, they are rejected for the same reasons set forth in the rejection of claims 1-2, 5-11 and 13-15 above.

18. Claims 3-4, 16-17, 20-21 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669], as applied to claims 1-2, 5-15, 18-19, 22-30 and 33 above, further in view of Official Notice

19. As to claim 3, Rossmann does not specifically teach the steps of:

d. determining if each telephone number record already exists in the electronic telephone directory, wherein each telephone number record includes a telephone number and an alphanumeric reference;

e. recording each telephone number record into the electronic telephone directory if the telephone number and alphanumeric reference do not already exist in the electronic telephone directory; and

f. providing notification to a user device if the at least one telephone record contains any telephone number or alphanumeric reference that already exists in the electronic telephone directory.

However, Official Notice is taken that this additional feature is well known in the art. For example, a user is warned when an attempt to overwriting a record of a file is made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to follow this conventional procedure to update Rossmann telephone directory because the procedure ensures the integrity of the directory.

20. As to claim 4, Rossmann does not specifically teach how a telephone record in the telephone directory is updated (e.g., deleting, adding, or modifying a record). However, Official Notice is taken that the listed feature is typical procedure in updating a database or telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adopt the conventional database updating procedure in updating Rossmann's system/method because such procedure ensures the integrity of Rossmann telephone directory.

21. As to claims 16-17, Rossmann teaches that the message containing at least one telephone number may be sent to a website (which is regarded as a user's terminal) [see the rejection of claim 1]. Rossmann does not specifically teach marking the message with a password, wherein the password is recorded into the web browser.
However, Official Notice is taken that marking a message with secret code or password for security purpose or for filtering unrelated email messages is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to mark Rossmann's email messages that is intended for automatic telephone

extraction at the receiving end, because by doing so it would properly filter out all unrelated emails from the extraction.

Further, Official Notice is taken that it is well known the browser is capable of remembering a user's password as an option (e.g., not having to remember or type the password each a user signs on the Internet). It would have been obvious to one of ordinary skill in the art at the time the invention was made that a Internet user may exercise such an option by allowing the browse to remember the password because it's convenience may out-weight the privacy.

22. As to claims 20-21 and 31-32, since the features of these claims can also be found in claims 1, 3-4 and 16-18, they are rejected for the same reasons set forth in the rejection of claims 1, 3-4 and 16-18 above.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Sheha et al. [U.S. 20030078035];

Jandel et al. [U.S. 6097793];

Crandell et al. [U.S. 20040240642]; and

Baumgartner et al. [U.S. 20050022115].

24. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

June 23, 2005

Wen Tai Lin
6/23/05